

X-949 US  
10/613,904

PATENT  
Conf. No. 7180

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Satish R. Ganesan et al.

Assignee: Xilinx, Inc.

Title: SoftPAL Implementation and Mapping Technology for FPGAs with Dedicated Resources

Serial No.: 10/613,904 File Date: 07/03/2003

Examiner: Naum B. Levin Art Unit: 2825

Docket No.: X-949 US Conf. No.: 7180

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Mail Stop Amendment  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION

Dear Sir:

This Response and Election is filed herewith in response to the Restriction dated September 19, 2005, which is set to expire on October 19, 2005.

It was stated in the Office Action that restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I:	Claims 1-41 and 46-48
Group II:	Claims 42-45 and 49

Applicants traverse the restriction and respectfully request the Examiner withdraw the restriction requirement. However, in order to comply with 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, to prosecute Group I, corresponding to Claims 1-41 and 46-48. Applicants hereby withdraw Claims 42-45 and 49, corresponding to Group II from prosecution, but reserve the right to request rejoinder and/or to prosecute any future cancelled claims in one or more subsequent divisional applications, without prejudice.



jam

Modified 02-03

PTO/SB/21 (01-03)

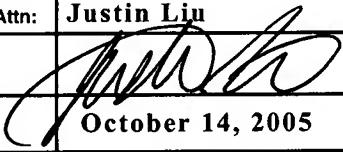
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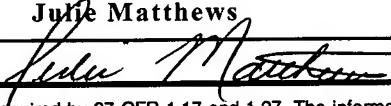
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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application / Conf. No.	10/613,904 / 7180
Mail Stop: AMENDMENT		Filing Date	July 03, 2003
		First Named Inventor	Satish R. Ganesan
		Examiner Name	Naum B. Levin
		Art Unit	2825
Express Mail Receipt No.		Patent No.	
Total Number of Pages in This Submission		Attorney Docket Number	X-949 US

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Amendment / Reply <ul style="list-style-type: none"> <li><input type="checkbox"/> Preliminary Amendment</li> <li><input type="checkbox"/> After Final</li> <li><input type="checkbox"/> Affidavit(s)/declaration(s)</li> </ul> <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Change Status to LARGE ENTITY <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Substitute PTO-1449(s) IDS by Applicant (PTO/SB/08A) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <ul style="list-style-type: none"> <li><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53</li> </ul>	<input type="checkbox"/> Assignment Papers (with Recordation Cover Sheet) <input type="checkbox"/> Declaration / Oath <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition - <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Return Receipt Postcard <input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Customer Number	Attn:	24309 (Customer Number)	Reg. Number 51,959
Signature			
Date	October 14, 2005		Charge any additional fees required/credit any overpayment to our Deposit Account Number: 24-0040

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this date:			
Typed or Printed Name	Julie Matthews		
Signature		Date	October 14, 2005

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

In order for the restriction to be proper, the Examiner must show that there is a serious burden on the Examiner if the claims are not restricted. MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming that Groups I and II are distinct (which the Applicants do not concede), the Examiner is required to examine the entire application if search and examination can be made without serious burden. Applicants believe the Examiner's own actions in this application clearly demonstrate that no such serious burden exists.

In particular, Applicants received a full first Office Action on the merits on March 21, 2005 in which the Examiner was able to search and examine all claims (Claims 1-49). In fact, the Examiner initially rejected all claims based on a single reference (Kaviani et al., U.S. Publication No. 2002/0079921 A1) in the March 21 Office Action. In Applicants' response to the march 21 Office Action, no claims were added, and only minor clarifying amendments were made in certain claims. Thus, it is unclear what basis the Examiner has in declaring that a serious burden exists.

That is, the Examiner presumably did not have any serious burden in preparing his first Office Action, since no prior restriction was required and since the Examiner was able to prepare a complete Office Action as to all claims. If no serious burden previously existed, Applicants are at a loss as to why a serious burden now exists. Applicants believe the interests of advancing prosecution would be best-served by examination of all claims, which have already been examined once by the Examiner.

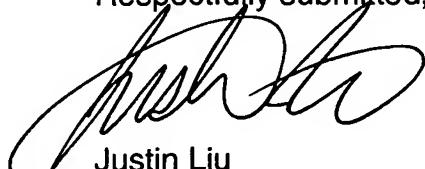
Therefore Applicants respectfully request withdrawal of the restriction requirement and allowance of the claims.

A listing of the claims in the present application is appended hereto, with current status.

The Director is hereby authorized to charge any fees which may be required or credit any overpayment to deposit account 24-0040.

Should the Examiner have any further comments and suggestions, it respectfully requested that the Examiner telephone the undersigned in order to expeditiously resolve any outstanding issues.

Respectfully submitted,



Justin Liu  
Attorney for Applicants  
Reg. No. 51,959  
Ph.: 408-879-4641

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on October 14, 2005.

Julie Matthews  
Name

  
Signature